

203391US6



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
MARI SAITO, et al. : EXAMINER: ABEL-JALIL, N.  
SERIAL NO: 09/785,204 :  
FILED: FEBRUARY 20, 2001 : GROUP ART UNIT: 2175  
FOR: INFORMATION PROCESSING :  
APPARATUS AND METHOD  
AND PROGRAM STORAGE  
MEDIUM

**PETITION UNDER 37 CFR §1.181(a)(3)**

This is a Petition pursuant to 37 CFR §1.181(a)(3) requesting that the Notice of Non-Compliant Brief mailed September 2, 2005, be withdrawn and that any appropriate credit for the clear Patent and Trademark Office (PTO) delay in processing the supplemental brief filed on October 29, 2005, be credited to any calculation of patent term extension. In addition, Appellants request an explanation of the over eleven month delay in responding to the supplemental appeal brief, particularly as it has been since March 8, 2004 that the Notice of Appeal was filed and since May 10, 2004, when the original appeal brief was filed.

**STATEMENT OF FACTS**

As noted above, the Notice of Appeal was filed on March 8, 2004 and the original appeal brief was filed May 10, 2004. In response, the PTO mailed a New Action (hereinafter "NA") on July 29, 2004, that reopened prosecution with two new grounds of rejection citing new references. On October 29, 2004, appellants filed a request for appeal reinstatement and a supplemental appeal brief under 37 CFR §41.37 that responded to the new grounds of rejection raised in the NA. On

September 2, 2005, the PTO mailed the above-noted Notification of Non-Compliant Brief with no explanation for the OVER ELEVEN MONTHS delay. This delay clearly violates MPEP guidelines. See MPEP § 1208, that has been in effect since August 2001, and that specifies that the examiner had an obligation to “furnish the appellant with a written statement in answer to the appellant’s brief within 2 months after the receipt of the brief by the examiner.”

Not only was there over an eleven month delay in mailing the Notification of Non-Compliant Brief Notice, at least one requirement was made based upon 37 CFR § 1.192(c) that was in clear error because that section no longer existed and because that section when it existed was clearly concerned with the ordering of main sections (I)-VIII) set forth therein, not typographical errors in titling subheadings.

The Notification of Non-Compliant Brief further incorrectly noted the supplemental brief to be “missing a concise explanation of the invention” as to Claims 7, 8, 11, 15, and 16. The response to the Non-Compliant Brief filed herewith points out in detail how the supplemental brief includes a “concise explanation of the invention” as to Claims 7, 8, 11, 15, and 16.as follows:

It is further noted the previously filed supplemental brief was and is believed to be fully compliant with 37 CFR § 41.37. In this regard, the supplemental brief was incorrectly noted to be “missing a concise explanation of the invention” as to Claims 7, 8, 11, 15, and 16.

However, page 4, lines 1-7 noted the following as to Claims 7 and 8:

With further regard to an exemplary disclosure of corresponding steps of independent Claim 7 and program storage medium of independent Claim 8, note the flow charts of Figure 3 and Figure 5. The corresponding Figure 3 description appears at page 17, line 21 through page 21, line 8, of the specification while the corresponding Figure 5 description appears at page 21, line 9 through page 22, line 20 of the specification. The description of the program storage medium at page 48, line 1-page 49, line 3 of the specification are also relevant as to exemplary support.

This explanation clearly references the specification by page and line numbers, and makes reference to the relevant the flow charts of Figure 3 and Figure 5. These flow charts do not include separate reference characters per se. However, to the extent that the PTO is suggesting that all of the illustrated flow chart steps (S1-S7 of Figure 3 and S11-S21 of Figure 5) must be individually noted, this has been done in the modified "SUMMARY OF THE CLAIMED SUBJECT MATTER" that appears below. In addition, the requirement is noted as being unreasonable in the Petition for Explanation and Withdrawal of Improper Requirements that is filed herewith.

Furthermore, a "concise" explanation as to Claims 15, and 16 was presented at page 5, lines 10-12, of the previously filed supplemental brief as follows:

The support for independent method Claim 15 and independent program storage medium Claim 16 is the same as that for independent apparatus Claim 9 as these claims parallel this independent apparatus claim.

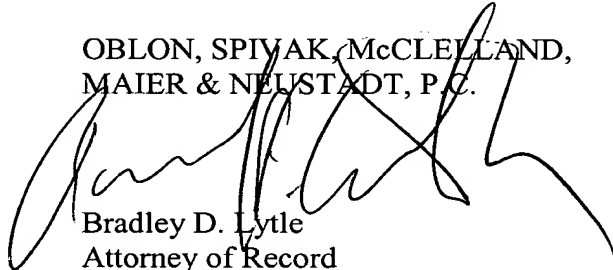
In addition, this response to the Non-Compliant Brief filed herewith pointed out the reason the objection made as to claim 11 was clearly in error and why a completely improper and impossible requirement was being made as to the sixth section of the supplemental brief (VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL) based upon an inaccurate statement that "the second grounds of rejection" was somehow omitted. Instead, it was pointed out how the section clearly stated BOTH grounds of rejection from the new Office Action mailed July 29, 2004. Moreover, it was noted that in addition to mistakenly noting that the second grounds of rejection had been omitted, the Requirement was in clear error in suggesting that this section of the supplemental brief "(VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL) must set forth "the basis for those contentions, including citations of authorities, statutes, and parts of the record relied upon."

ACTION REQUESTED

It is respectfully requested that the Examiner be instructed to withdraw the improper Notification of Non-Compliant Brief Notice, be instructed to notify appellants the reason for the over eleven month delay, and be instructed to promptly act on either the newly filed second supplemental appeal brief or the supplemental appeal brief filed October 29, 2004, without further delay. An appropriate adjustment of the calculation of patent term is further requested. At least the requested prompt Action and patent term adjustment are clearly outstanding matters requiring an actual decision be made as to the present petition.

Respectfully Submitted,

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